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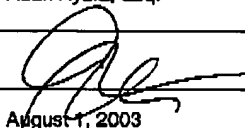
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/056,312	
	Filing Date	January 24, 2002	
	First Named Inventor	Daryl S. Meredith et al.	
	Group Art Unit	3724	
	Examiner Name	I. Hamilton	
Total Number of Pages in This Submission	6	Attorney Docket Number	TN-1488

ENCLOSURES (check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Adan Ayala, Esq.
Signature	
Date	August 1, 2003

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Serial N . 10/056,312

Response to Office Action of May 7, 2003

UTILITY PATENT

B&D No. TN -1488

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E. Hamilton
E. Hamilton
8/6/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Daryl S. Meredith et al.**

Serial No.: 10/056,312

Examiner: **I. Hamilton**

Filed: **January 24, 2002**

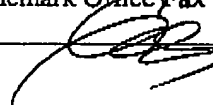
Group Art Unit: 3724

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (703) 872-9302 on Aug 1, 2003


Adan Ayala

Dear Sir:

This is in response to the Office Action mailed on May 7, 2003.

The Examiner has requested an election between Claims 1-2 (Group I), 3-17 (Group II) and 18-24 (Group III). During a telephone conversation with the Examiner, the Applicants' attorney elected Group I, i.e., Claims 1-2. Applicants hereby affirm such election.

Serial No. 10/056,312

Response to Office Action of May 7, 2003

UTILITY PATENT

B&D No. TN-1488

The Examiner has rejected Claims 1-2 under 35 USC § 103(a) as being unpatentable over the prior art disclosed on page 1, lines 7-20, of the Specification ("the Described Prior Art") in view of US Patent No. 5,393,270 ("Grobbelaar"). This rejection is respectfully traversed.

Claim 1 calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly and having a plane, a saw assembly including a motor, and a blade disposed on an arbor, the arbor having a first gear meshing with an idler gear, which meshes in turn with a second gear driven by the motor, and a pivot arm pivotally attached to the table and supporting the saw assembly.

Admittedly, the Described Prior Art discloses all elements called for in Claim 1 except for the idler gear, which meshes with the first and second gears. The Examiner relies on Grobbelaar to provide the disclosure for such idler gear. However, there is no teaching or suggestion in either the Described Prior Art or Grobbelaar to modify the Described Prior Art as suggested by the Examiner.

Under the MPEP, in order for an obviousness rejection to be proper, there must be some suggestion or motivation to combine the teachings of the references. MPEP § 2143.

Accordingly, "it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference [sic] before him to make the proposed substitution, combination or other modification." MPEP § 2143.01.

Serial No. 10/056,312

Response to Office Action of May 7, 2003

UTILITY PATENT

B&D No. TN -1488

In the present case, there is no teaching or suggestion in the Described Prior Art to add an idler gear, as suggested by the Examiner. Similarly, there is no teaching or suggestion in Grobbelaar to add an idler gear to a miter saw built according to the Described Prior Art.

The Examiner argues that a person would have combined the Described Prior Art and Grobbelaar "in order to provide a safety mechanism, such as an idling mode of operation for the saw, to disengage the turning of the blade while the motor is turning." However, such rationale is incorrect. Most, if not all, miter saws are not provided with any such idling modes. Indeed, the miter saw presently incorporating the claimed invention does not have any such idling mode.

Having such idling mode would lower the cutting efficiency of the miter saw, as the blade would stop turning if it gets jammed into wood. This would render the miter saw of the Described Prior Art unsatisfactory for its intended purpose, i.e., cutting wood. According to the MPEP, if a proposed modification would render the prior art invention being modified, "then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01, at 2100-127 (8th ed., Rev. 1, Feb. 2003). Because the Examiner's proposed combination would be unsatisfactory for its intended purpose, no suggestion or motivation exists to make the proposed modification. Therefore, the obviousness rejection is improper under MPEP § 2143.

Furthermore, the claimed invention has clear advantages over the prior art. Because of the idler gear, the transmission between the motor and the blade can be modified to increase cutting capacity. This is evidenced by comparing the cutting capacity of the miter saws respectively built according to the Described Prior Art and to the claimed invention.

Serial No. 10/056,312

Response to Office Acti n of May 7, 2003

UTILITY PATENT

B&D No. TN -1488

The assignee manufactures and sells the DeWalt DW705 and DW706 miter saws. The DW705 is built according to the Described Prior Art, whereas the DW706 is built according to the claimed invention, respectively. Both miter saws have a 12-inch blade.

The top vertical cutting capacity of the DW705 (the miter saw according to the Described Prior Art) when cutting baseboard against the miter saw's fence is 4.25 inches. The top vertical cutting capacity of the DW706 (the miter saw according to the claimed invention) when cutting baseboard against the miter saw's fence is 6 inches. That's an increase in cutting capacity of more than 41% over the prior art miter saw, even though the blade size is the same.

Similarly, the top vertical cutting capacity of the DW705 (the miter saw according to the Described Prior Art) when cutting vertically-nested crown molding is 5.25 inches. The top vertical cutting capacity of the DW706 (the miter saw according to the claimed invention) when cutting vertically-nested crown molding is 6.625 inches. That's an increase in cutting capacity of more than 26% over the prior art miter saw, even though the blade size is the same.

Such enormous increases are obtained by the use of an idler gear in the transmission, which allows the designers to open a pocket to provide increased clearance, as described in page 11 of the Specification. Such increased clearance translates into substantial increases in cutting capacity.

Because neither the Described Prior Art nor Grobbelaar teach or suggest such advantageous arrangement, they cannot render Claims 1-2 unpatentable.

Serial No. 10/056,312

Response to Office Action of May 7, 2003

UTILITY PATENT

B&D No. TN-1488

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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Phone No. (410) 716-2368